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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,752	01/16/2002	Sean Brennan	16375-00025	7828
21186	7590	09/08/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				SIMITOSKI, MICHAEL J
ART UNIT		PAPER NUMBER		
		2134		

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/050,752	BRENNAN, SEAN
	Examiner Michael J. Simitoski	Art Unit 2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 February 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) 1-3, 14 and 15 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 4-13 and 16-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                              |                                                                                           |
|----------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/16/02</u> . | 6) <input type="checkbox"/> Other: _____ .                                                |



**DETAILED ACTION**

1. The IDS of 1/16/2002 was received and considered.
2. Claims 1-20 are pending.

*Election/Restrictions*

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to a method of login authentication that employs a token with a seed value, classified in class 713, subclass 184.
  - II. Claims 4-20, drawn to a method of authentication across multiple web sites, classified in class 713, subclass 168.
4. The inventions are distinct, each from the other because Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as authenticating to multiple web sites using different authentication mechanisms. See MPEP § 806.05(d).
5. Only if the above Invention II is elected, this application will contain claims directed to the following patentably distinct species of the claimed invention: Group II-a, claims 11-13 and Group II-b, claims 14-15. Group II-a is directed to a hardware-based token and Group II-b is directed to a software-based token.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 4-9, 16-19 & 20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Thomas Brennan on 8/29/2005 a provisional election was made without traverse to prosecute the invention of Group II-b, claims 4-13 & 16-20. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-3 & 14-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Drawings*

7. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because at least Fig. 1 is handwritten and difficult to read. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite “complex code”, however “complex” is not clearly defined in the specification so as to definitively differentiate a complex code from a simple code.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 16-17 & 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 16-17, the claims recite “complex code”, however “complex” is vague and indefinite.

Regarding claim 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

#### *Claim Rejections - 35 USC § 102*

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 4-12 & 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by “RSA Web Security Portfolio – How RSA SecurID Agents Can Secure Your Website” by RSA Security, Inc. (RSA).

Regarding claims 4-8 & 18-19, RSA discloses providing two separate user authentication methods (p. 2, ¶1), enabling a user to communicate authentication data to both authentication methods to a first web site using the Internet (p. 2, §III, ¶2), enabling the communication of at least some of the authentication data from the first web site to a second web site using the

Internet (p. 3, ¶4-6) and wherein both web sites are involved in user authentication using the authentication data (p. 3, ¶5-6).

Regarding claim 9, RSA discloses employing a password/secret PIN (p. 2, ¶1).

Regarding claims 10-12, RSA discloses employing a token/random number generator (p. 2, ¶1 & p. 3, §III, ¶5).

Regarding claim 20, RSA discloses embedding the token in a device such as a cell phone (p. 2, §III, ¶5).

#### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over RSA, as applied to claim 4 above, in further view of Network Security Essentials Applications and Standards by Stallings.

Regarding claims 16-17, RSA lacks explicitly that the authentication method employs a fixed complex code which comprises a public key infrastructure. However, RSA discloses that the authentication token is transmitted using SSL (p. 3, §III, ¶2). Further, Stallings teaches that SSL involves a key exchange, for instance RSA key exchange, where a secret key is encrypted with the receivers RSA public key (p. 214). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to explicitly employ a fixed

complex code which comprises a public key infrastructure. One of ordinary skill in the art would have been motivated to perform such a modification to utilize an RSA public key to exchange keys, as taught by Stallings (p. 214).

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **RSA**, as applied to claim 11 above, in further view of U.S. Patent Application Publication 2001/0045451 to Tan et al. (**Tan**) in further view of “eToken: The Key to Security for the Internet Age” by **Aladdin**. RSA lacks explicitly a USB-based token being accessed by a browser. However, Tan teaches that to allow access to a web site using a smart card, the browser can read necessary access information directly from the smart card and pass the information to the server to which the user is authenticating (¶6-11). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the RSA security token to communicate electronically with the web browser. One of ordinary skill in the art would have been motivated to perform such a modification to pass the generated code to the server for use in authentication, as taught by Tan (¶6-11). Further, Aladdin teaches that using USB tokens for authentication allows the user to take advantage of the USB ports included in millions of PCs (p. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify RSA to include the SecurID token in a USB-based device. One of ordinary skill in the art would have been motivated to perform such a modification to take advantage of millions of USB-ready PCs for authentication, as taught by Aladdin (p. 1).

### *Conclusion*

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300  
(for formal communications intended for entry)

**Or:**

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJS  
August 30, 2005

GREGORY MORSE  
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